

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 09/479,648

Confirmation No.: 3344

Filed: 7 January 2000

For: METHOD OF APPLYING ADHESIVE COATED FILM

Remarks

The Final Office Action mailed 7 October 2002 has been received and reviewed. Claims 20-31, 34-42, and 45-66 remain pending. Reconsideration and withdrawal of the rejections are respectfully requested.

Amendments to the Specification

Two amendments to the specification are presented for entry by the Examiner, with both amendments being presented pursuant to the request of the Examiner. Applicants respectfully submit that the amendments do not present new matter. Their entry is respectfully requested.

The 35 U.S.C. §112, First Paragraph, Rejection

The Examiner rejected claims 41-42, 45-46, and 62-63 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner objects to the recitation of "wall" in the claims at issue. Applicants respectfully traverse this rejection for the following reasons.

When presenting a rejection for "written description" under 35 U.S.C. § 112, first paragraph, the proper standard to apply is whether one of ordinary skill in the art would recognize that Applicants had possession of the invention as claimed. Furthermore, the Office bears the burden of providing reasoning or evidence as to why one of ordinary skill in the art would not recognize that Applicants had possession of the claimed invention at the time the application was filed. *See, e.g.,* MPEP § 2163.02 (August 2001).

The rejection presented with respect to claims 41-42, 45-56 and 62-63 fails to apply the proper standard and/or provide reasoning or evidence as to why one of ordinary skill in the art would not recognize that Applicants had possession of the claimed invention. Rather, the

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rejection is based on assertions regarding the subjective intent of the Applicants. That is not the proper standard to apply.

As noted above, the proper standard is whether one of ordinary skill in the art would recognize that Applicants had possession of the invention as claimed. Given the wide variety of surfaces recited in the specification with which the invention could be used, Applicants submit that one of ordinary skill in the art would recognize that the Applicants clearly considered application of films using the methods and apparatus of the present invention to "walls" as falling within the scope of the invention as recited in claims 41-42, 45-56 and 62-63.

Further, Applicants note that the rejection includes a reference to "claim 14." *See*, Office Action, p. 3. l. 4-5. No claim 14 is pending in the application and, as such, Applicants respectfully request clarification of this portion of the rejection.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 41-42, 45-56 and 62-63 under § 112, first paragraph.

The 35 U.S.C. §103 Rejection

Claims 20 and 22-23 were rejected under 35 U.S.C. §103 as being unpatentable over Gladen (U.S. Patent No. 3,562,059).

Applicants incorporate herein all of the comments provided with respect to the rejections under § 103 over Gladen in previous responses.

Furthermore, Applicants respectfully submit that the Office has failed to establish a critical assertion on which the entire rejection is premised, namely that a Teflon cloth as disclosed by Gladen can be equated with a "Heat Neutral Pressure Source" as recited in independent claim 20. Applicants note that the film 5 of Gladen is heated through the Teflon cloth 11 by heated platen 9. As a result, the Teflon cloth must inherently be highly thermally conductive or the process of Gladen would not work. In other words, the film 5 and underlying foam 6 would not be heated by the platen 9 because the Teflon cloth 11 would not conduct thermal energy from the platen 9 and to the film 5 and foam 6 with any efficiency.

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In contrast, the present invention provides a definition of the recited element, a "Heat Neutral Pressure Source," that precludes significant thermal energy transfer. "With respect to the thermal conductivity characteristics, the composition of the film-contacting portion of the Heat Neutral Pressure Source does not appreciably conduct heat either to or from the surface of the film as the film is applied under pressure to a surface on a substrate." Specification, p. 5, l. 22-25.

In view of the above, Applicants submit that Gladen cannot support the proposed rejection because it does not disclose or suggest a "Heat Neutral Pressure Source" as recited in claims 20 and 22-23. Furthermore, modification of Gladen to include a "Heat Neutral Pressure Source" would result in a process that does not work. Reconsideration and withdrawal of the rejection of claims 20 and 22-23 over Gladen are, therefore, respectfully requested.

Claims 21, 24-28, 57-61, and 65-66 were rejected under 35 U.S.C. §103 as being unpatentable over Hargarter et al. (U.S. Patent No. 5,674,600) in view of Gladen (U.S. Patent No. 3,562,059).

Applicants incorporate herein all of the comments provided with respect to the rejections under § 103 over Hargarter et al. in view of Gladen in previous responses.

Furthermore, Applicants note that the discussion presented above with respect to the failure of Gladen to teach or suggest a "Heat Neutral Pressure Source" as recited in claims 20 and 22-23 applies equally to the rejection of claims 21, 24-28, 57-61, and 65-66 over Hargarter et al. in view of Gladen. Hargarter et al. does not remedy the deficiencies of Gladen, nor is there any assertion that Hargarter et al. does so.

In fact, Hargarter et al. strengthens the arguments presented above with respect to, e.g., claim 25 in the current rejection. Hargarter et al. does so by disclosing only rollers that are either heated (Col. 7, l. 1), steel (Col. 12, l. 26), or rubber (Col. 12, l. 26). There is no discussion or suggestion in Hargarter et al. that a roll form of a "Heat Neutral Pressure Source" is to be supplied or used.

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With respect to claim 26, Applicants note that no support has been provided to indicate where any of the cited references disclose or suggest an annular "Heat Neutral Pressure Source" as recited in the claim.

With respect to claim 60, Applicants note that no support has been provided to indicate where any of the cited references disclose or suggest an "open cell foam" for a "Heat Neutral Pressure Source" as recited in the claim.

For the above reasons, reconsideration and withdrawal of the rejection of claims 21, 24-28, 57-61, and 65-66 over Hargarter et al. in view of Gladen are, therefore, respectfully requested.

Allowable Subject Matter

Applicants thank the Examiner for notification that claims 29-31, 34-40, and 64 recite allowable subject matter.

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Summary

It is respectfully submitted that the pending claims 20-31, 34-42, and 45-66 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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By

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PATENT TRADEMARK OFFICE

05 DECEMBER 2002

Date

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: BOX AF, Washington, D.C. 20231, on this 5th day of December, 2002, at 3:15 p.m. (Central Time).

By: 

Name: Rachel Gagliardi-Grabau

**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS
INCLUDING NOTATIONS TO INDICATE CHANGES MADE**

Serial No.: 09/479,648

Docket No.: 54655US009 (formerly 54655USA1B.009)

Amendments to the following are indicated by underlining what has been added and bracketing what has been deleted. Additionally, all amendments have been marked in bold typeface.

In the Specification

The paragraph beginning at page 4, line 11, has been amended as follows:

-- As will be readily understood by anyone who has attempted to hang wallpaper, the application of an adhesive-coated film to a vertical surface is very cumbersome and time-consuming. Application of such materials to challenging surfaces such as truck trailers is that much more difficult. At the least the wall is usually even and does not contain compound geometrical or irregular surfaces. Typically, the size of a wallpaper section is about 70 cm wide and about 2.5 m long. **[In the pertinent art of the present invention, t]** The application of an adhesive-coated film to a vertical side of a truck trailer occurs in a vastly different environment: a substrate that is often filled with topographical irregularities and film sections having a size of about 120 cm wide and about 3m long. Very skilled persons are needed for this assembly, and such assembly takes very long times: on the order of 22 hours per truck trailer. --

The paragraph beginning at page 8, line 28, has been amended as follows:

-- In another aspect of the present invention, a kit for application of heat and pressure is provided comprising a heat source adapted for application of heat to a film, and a pressure source that is heat neutral, which may be used in conjunction with the heat source for application of a film to an intended substrate; **a film having a removable adhesive coated thereon may also be included.** Another aspect of the present invention is to provide a unitary article for application of both heat and pressure to an adhesive coated film. --